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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/871,364	05/31/2001	Barry E. Willner	I01.038	1751

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EXAMINER

DINH, KHANH Q

ART UNIT	PAPER NUMBER
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2151

DATE MAILED: 10/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/871,364

Applicant(s)

WILLNER ET AL.

Examiner

Khanh Dinh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>5/31/01</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-42 are presented for examination.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-42 are rejected under 35 U.S.C. 102(e) as being anticipated by Devine et al., US pat. No.6,631,402.

As to claim 1, Devine disclose a method of facilitating access with respect to an information address and an electronic message, wherein the information address is associated with information content and the electronic message is associated with a message address, comprising:

determining that the information address is related to the electronic message

(detailing data and marketing news messages, see abstract, fig.2, col.7 lines 8-43)

and associating the information address with at least one of: (i) the electronic

message, and (ii) the message address (see col.7 line 44 to col.8 line 36 and 10 lines 4-49).

As to claim 2, Devine discloses the information address comprises a uniform resource locator address, the information content comprises a Web page, the electronic message comprises an e-mail message, and the message address comprises an electronic mail address from which the e-mail message originated (information of the email messages, see col.9 lines 6-58 and col.16 line 39 to col.17 line 49).

As to claims 3 and 4, Devine discloses providing an indication of the information address in association with an indication of the electronic message and an address icon displayed proximate to the indication of the electronic message in a list of electronic message indications (see col.17 line 33 to col.18 line 42 and col.20 line 51 to col.21 line 40).

As to claims 5 and 6, Devine discloses the activation of the address icon results in display of at least one of: (i) the information address, and (ii) the information content and further discloses a message icon displayed proximate to the indication of the information address in a list of information address indications (see col.17 line 33 to ! col.18 line 42 and col.20 line 51 to col.21 line 40).

As to claims 7 and 8, Devine discloses wherein activation of the message icon results in display of at least one of: (i) the message address, and (ii) the electronic message and

storing an indication of the information address in association with an indication of the electronic message (see col.17 line 33 to col.18 line 42 and col.20 line 51 to col.21 line 40).

As to claims 9-10, Devine discloses the stored indication of the information address comprises at least one of: (i) the information address, and (ii) the information content (see col.17 line 33 to col.18 line 42 and col.20 line 51 to col.21 line 40).

As to claims 11 and 12, Devine discloses determining metadata associated with at least one of: (i) the electronic message, and (ii) the information content, wherein said storing is performed in accordance with the metadata and the metadata is associated with at least one of: (i) hypertext markup language information, (ii) extensible markup language information, (iii) bookmark exchange language information, (iv) keyword information, (v) category information, (vi) third-party information, (vii) rating information, (viii) quantity information, (ix) date information, (x) an information source, and (xi) a plurality of metadata types (see col.17 line 33 to col.18 line 42 and col.20 lines 3-50).

As to claims 13-15, Devine discloses the information is stored in a directory structure in accordance with the metadata, wherein a plurality of information addresses are associated with the indication of the electronic message and associated with the

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indication of the information address (see col.17 line 33 to col.18 line 42 and col.20 line 51 to col.21 line 40).

As to claims 16 and 17, Devine discloses associating is performed by at least one of: (i) a user device, (ii) a personal computer, (iii) a portable computing device, (iv) a personal digital assistant, and (v) a wireless telephone and further discloses the information address is associated with accessing the information content via at least one of: (i) the Internet, (ii) a Web site, (iii) a public network, (iv) a public switched telephone network, (v) a proprietary network, (vi) a cable network, (vii) a satellite network, (viii) a wireless network, and (ix) a Bluetooth network (see figs. 9a-9f, col.17 line 33 to col.18 line 42 and col.20 line 51 to col.21 line 40).

As to claim 18, Devine discloses determining at least one of: (i) whether information will be stored, (ii) how long information will be stored, (iii) a device at which information will be stored, (iv) whether information will be deleted, (v) whether information will be replaced, and (vi) whether another electronic message will be generated (see col.20 line 3 to col.21 line 12 and col.22 lines 21-56).

Claim 19 is rejected for the same reasons set forth in claim 1.

As to claims 20 and 21, Devine discloses said storage device further stores at least one of: (i) an electronic message database, (ii) an information address database, (iii) a user preference database, and (iv) a pre-determined rule database adapted to communicate with at least one of: (i) an information server, (ii) another user device, (iii) a third-party device, and (iv) a payment device (using database 273 and 283 fig.6 to process data information from clients, see col.13 line 24 to col.14 line 50 and col.22 lines 21-56).

Claim 22 is rejected for the same reasons set forth in claim 1.

As to claim 23, Devine discloses a computer-implemented method of facilitating access to a Web page, comprising:
receiving an e-mail message including a uniform resource locator address associated with the Web page and determining metadata associated with at least one of: (i) the e-mail message, and (ii) the Web page (see fig.4, col.5 line 22 to col.6 line 24), storing the uniform resource locator address in a directory structure in accordance with the metadata (see col.6 line 56 to col.7 line 59);
and storing with the uniform resource locator address an indication associated with the e-mail message (see col.7 line 60 to col.8 line 36).

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As to claim 24, Devine discloses a method of facilitating storage of an information address associated with information content stored at an information server (24 fig.2), comprising:

determining the information address and determining metadata associated with the information content (detailing data and marketing news messages, see abstract, fig.2, col.7 lines 8-43) and determining at a user device remote (20 fig.2) from the information server whether the information address will be stored based on the metadata (see col.7 line 44 to col.8 line 36 and 10 lines 4-49).

As to claims 25 and 26, Devine discloses at least one of: (i) a uniform resource locator address, (ii) an Internet protocol address, (iii) file transfer protocol information, (iv) Bluetooth information, and (v) a telephone number and further receiving the information address from a user, (ii) extracting the information address from an electronic message, (iii) extracting the information address from an instant message, (iv) extracting the information address from information content, and (v) retrieving a pre-stored indication of the information address (see col.20 line 3 to col.21 line 12 and col.22 lines 21-56).

Claim 27 is rejected for the same reasons set forth in claim 12.

As to claims 28 and 29, Devine discloses determining the metadata comprises at least one of: (i) receiving the metadata from the information server, (ii) evaluating the

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information content, and (iii) receiving the metadata from a third-party and the information address will be stored is further based on at least one of: (i) a pre-determined rule, and (ii) a user preference (see col.20 line 3 to col.21 line 12 and col.22 lines 21-56).

As to claims 30-33, Devine discloses storing the information address at the user device, performed in accordance with the metadata, stored in a directory structure in accordance with the metadata and storing the metadata at the user device (see col.13 line 24 to col.14 line 50 and col.22 lines 21-56).

As to claim 34, Devine discloses determining, based on the metadata, at least one of: (i) how long the information address will be stored, (ii) a device at which the information address will be stored, (iii) whether the information address will be deleted from the user device, (iv) whether another information address will be deleted from the user device, (v) whether another information address will be replaced by the information address at the user device, and (vi) whether an e-mail message will be generated (see col.20 line 3 to col.21 line 12 and col.22 lines 21-56).

Claims 35 and 36 are rejected for the same reasons set forth in claims 16 and 17 respectively.

Claims 37-40 are rejected for the same reasons set forth in claims 19-21 and 24 respectively.

As to claim 41, Devine discloses a computer-implemented method of facilitating storage of a uniform resource locator address associated with a Web page, comprising:

receiving at a user device (client 10 fig.2) the uniform resource locator address and determining at the user device metadata associated with the uniform resource locator address (verifying and processing client's request, see fig.2, col.6 line 56 to col.7 line 43);

determining at the user device (client 10 fig.2) whether the uniform resource locator address will be stored based on the metadata and storing the uniform resource locator in a directory structure in accordance with the metadata (see col.7 line 44 to col.8 line 64 and col.10 lines 3-64).

As to claim 42, Devine discloses a method of facilitating storage of a user identifier associated with a user device, comprising:

determining the user identifier and determining metadata associated with the user device (verifying and processing client's request, see fig.2, col.6 line 56 to col.7 line 43); and determining at an information server (24 fig.2) remote from the user device (10 fig.2) at least one of: (i) whether the user identifier will be stored based on the metadata, and (ii) how the user identifier will be stored based on the metadata (see col.7 line 44 to col.8 line 64 and col.10 lines 3-64).

Other prior art cited

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Brandt et al, US pat. No.6,714,979.
- b. Brandt et al, US pat. No.6,377,993.
- c. Ling et al, US pat. No.6,799,148.
- d. Alexander et al. US pat. No.6,748,343.
- e. Barry et al., US pat. No.6,615,258.

Conclusion

5. Claims 1-42 are rejected.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh Dinh whose telephone number is (703) 308-8528. The examiner can normally be reached on Monday through Friday from 8:00 A.m. to 5:00 P.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Zarni Maung, can be reached on (703) 308-6687. The fax phone number for this group is (703) 872-9306.

A shortened statutory period for reply is set to expire THREE months from the mailing date of this communication. Failure to response within the period for response

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will cause the application to become abandoned (35 U. S. C . Sect. 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(A).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305 -9600.



Khanh Dinh
Patent Examiner
Art Unit 2151
10/16/2004